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EXAMINER BALAOING, ARIEL A				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/501,019

Applicant(s)

SEBIRE ET AL.

Examiner

ARIEL BALAOING

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-15 and 18-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-13, 15 and 18-25 is/are rejected.
- 7) ☒ Claim(s) 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB008)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Paper No(s)/Mail Date _____
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 06/02/2008 have been fully considered but they are not persuasive.

Regarding the applicant's arguments that "However, it is respectfully pointed out that the cited paragraphs of Mildh et al. explain how the network informs an arrived mobile station to select its mode. Such a method in which, after appearing that the cell supports the UMTS service, another SI message is broadcast including a description of the (second) channel where lu information for mobile stations is placed is not disclosed. Thus, Mildh et al. do not disclose or suggest the claimed feature of "... describing a second broadcast control channel ..." or " ... then a second broadcast control channel through which service information of the one of the two or more service modes ..." as recited in Applicant's independent claims 18 and 10, respectively." (see page 5 last paragraph); the examiner respectfully disagrees. As can be seen in paragraph 16 and 17, a first broadcast message is sent to a mobile terminal using a system information message. This message details which network the mobile should camp on using a spare bit within the system information message and therefore includes pilot channel information (PBCCH). Paragraph 18 further shows the mode selection via a network control using the various control channels available and determines selection of a core network based on mode determination.

Regarding the applicant's request for clarification with regards to claim priority of MILDH to US provisional patent application 60/280,305 ('380), it is noted that the cited

subject matter is disclosed in the specification of the '380 application. Page 2 of the specification details mode selection between 2G/3G GERAN networks, section 1.6.1.1 and 1.6.2 details the use of a spare bit of a system information message to determine a network selection, and section 1.6.3 detail the various control channels used.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., there is only one spare bit left in the SI3 Rest Octets and there is no room for the required information in other messages sent regularly to the BCCH) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, MILDH discloses the use of a spare bit within a system information message (SI2 message) to determine mode selection, while the applicant's disclosure of the prior art teaches that it was known to use the system information 3 message to inform a mobile of its service mode. Therefore the combination of MILDH and the applicant's description of the prior art discloses the claimed limitation. Similarly, the combination of MILDH and the ETSI 3GPP 04.18 teaches the use of system information 13 messages.

Regarding claim 19, the applicant argues "Moreover, with specific regard to prior dependent claim (now claim 19), it is noted that the Patent Office contends that "Mildh further discloses said first channel being BCCH of the GSM system and said second channel being PBCCH of the GSM system (paragraph 19)." However, Applicant respectfully points out that paragraph 19 only mentions alternative channels for

broadcasting the message with selection information. A first channel for one purpose and a second channel for another purpose are not disclosed or suggested." (see page 8 of the remarks); the examiner respectfully disagrees. Paragraph 19 details the various channels which can be used within the system described for mode selection and therefore any and all control channels could be used for the first and second broadcast channels for provisioning of system information.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 9-13, 15, 18, 19, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over MILDH et al (US 2002/0193139 A1) in view Applicant's description of the prior art.

Regarding claim 9, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. MILDH in view of the applicant's description of the prior art further discloses locating the spare bit in a rest octet of the system information 3 message (MILDH – paragraph 16, 21; applicant's disclosure of the prior art – paragraph 6; MILDH shows the rest octet containing information distributed to mobile stations in the cell capable of Iu support, while applicant's disclosure of the prior art show a spare bit used within a an SI3 message for providing Iu support information).

Regarding claim 10, MILDH discloses an apparatus comprising: a controller having two or more service modes, where the controller wirelessly communicates to at least one wireless terminal an availability of at least one of the two or more service

modes through the use of a System Information message of a Global System for Mobile communications (GSM) system transferred on a first broadcast control channel, wherein an availability of one of the two or more service modes is indicated through a single spare bit in the first message (paragraph 16-21; paragraph 16 shows one bit used to select a 2G or 3G network in a SI/PSI message), and, if it is indicated that the one of the two or more service modes is available, then a second broadcast control channel through which service information of the one of the two or more service modes is to be broadcast is described (paragraph 18-32). Although MILDH discloses the use of System Information type messages, MILDH does not disclose the use of a System Information 3 message of a Global system for Mobile communication system. In the same field of the endeavor, Applicant's description of the prior art discloses a first message is a system information 3 of GSM system, said spare bit is used for indicating whether said cell supports an UMTS service (paragraph 6). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify MILDH to include at least one spare bit as disclosed by the applicant's description of the prior art, since a proposal by Ericsson Ltd for adding a two bit field within a part of the SI3 message was known and would result in informing mobile stations about an lu service mode.

Regarding claim 11, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. MILDH further disclose wherein the first broadcast control channel is a broadcast control channel (BCCH) of the GSM system (paragraph 18-21).

Regarding claim 12, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. The combination MILDH and the applicant's description of the prior art further disclose wherein the single spare bit is a spare bit in the SI3 rest octets (MILDH – paragraph 16, 21; Applicant's description of the prior art – paragraph 6).

Regarding claim 13, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. MILDH further disclose wherein the single spare bit is an lu support indicator (paragraph 16, 21).

Regarding claim 15, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. MILDH further disclose wherein the apparatus comprises a base station controller in a GSM/EDGE radio access network (GERAN) cell (paragraph 11, 14).

Regarding claim 18, MILDH discloses a method for broadcasting of a possibility to use UMTS service **26** in a cell under control of a GSM/EDGE radio access network (GERAN) type radio access network **20, 24** having an lu interface to a 3G core network **22**, a radio resource management system of the radio access network comprising a first and a second message, which messages are transferred on a first broadcast control channel in said cell [**BCCH**], and which first message has at least one spare bit, wherein said first message is System Information of GSM system, and the method comprises using said at least one spare bit for indicating whether said cell supports an UMTS service (paragraph 16, 21), and in a favourable case in which the GERAN controlled cell is determined to support the UMTS service, describing a second broadcast control

channel [PBCCH] in the second message to at least lu mobile stations (paragraph 22-33), and broadcasting UMTS service information for lu mobile stations on the second broadcast control channel (paragraph 6, 8-10, 16-18). Although MILDH discloses the use of System Information type messages, MILDH does not disclose at least one spare bit, characterized in that said first message is system information 3 of GSM system. In the same field of the endeavor, Applicant's description of the prior art discloses a first message is a system information 3 of GSM system, said spare bit is used for indicating whether said cell supports an UMTS service (paragraph 6). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify MILDH to include at least one spare bit as disclosed by the applicant's description of the prior art, since a proposal by Ericsson Ltd for adding a two bit field within a part of the SI3 message was known and would result in informing mobile stations about an lu service mode.

Regarding claim 19, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. MILDH further discloses said first channel being BCCH of the GSM system and said second channel being PBCCH of the GSM system (paragraph 19).

Regarding claim 25, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. MILDH in view of the applicant's description of the prior art further discloses said cell being barred against UMTS operation through lu interface by indicating with information that UMTS service is not supported in said cell (paragraph 11, 15-19).

4. Claims 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over MILDH et al (US 2002/0193139 A1) in view Applicant's description of the prior art and further in view of ETSI 3GPP 04.18 v 9.0.

Regarding claim 20, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. MILDH further discloses the radio access network supporting the UMTS-service and not supporting a GPRS service, wherein said first message further comprises an lu indicator field (paragraph 6, 15-18). However, MILDH in view of the applicant's disclosure of the prior art does not expressly disclose wherein said second message is System Information 13alt of the GSM system and is legible only to lu mobile stations. ETSI 3GPP 04.18 v 9.0 discloses wherein a second message is System Information 13 of the GSM system and is legible only to lu mobile stations (page 148, section 9.143a; page 244-245, section 10.5.2.26a). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify MILDH in view of the applicant's disclosure of the prior art to include the use of System Information 13, as taught by ETSI 3GPP 04.18 v9.0, since System Information 13 is a well known and conventional protocol used in GSM system to provide information related to GPRS within a cell (see page 148).

Regarding claim 21, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. MILDH further discloses the second channel being available also to the GPRS service (paragraph 6, 15-18). However MILDH in view of the applicant's disclosure of the prior art does not disclose wherein said second message is System Information 13 of the GSM system. ETSI 3GPP 04.18 v 9.0

discloses wherein a second message is System Information 13 of the GSM system (page 148, section 9.143a; page 244-245, section 10.5.2.26a). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify MILDH in view of the applicant's disclosure of the prior art to include the use of System Information 13, as taught by ETSI 3GPP 04.18 v9.0, since System Information 13 is a well known and conventional protocol used in GSM system to provide information related to GPRS within a cell (see page 148).

Regarding claim 22, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. MILDH further discloses the second channel being available also to the GPRS service (paragraph 6, 15-18). However MILDH in view of the applicant's disclosure of the prior art does not disclose wherein said message System Information 13 is legible only to lu mobile stations and Gb mobile stations. ETSI 3GPP 04.18 v 9.0 discloses wherein said message System Information 13 is legible only to lu mobile stations and Gb mobile stations (page 148, section 9.143a; page 244-245, section 10.5.2.26a). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify MILDH in view of the applicant's disclosure of the prior art to include the use of System Information 13, as taught by ETSI 3GPP 04.18 v9.0, since System Information 13 is a well known and conventional protocol used in GSM system to provide information related to GPRS within a cell (see page 148).

Regarding claim 23, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. MILDH further discloses the second channel being

not available to the GPRS service (paragraph 6, 15-18). However MILDH in view of the applicant's disclosure of the prior art does not disclose wherein a description of the second channel in the message System Information 13 is legible only to lu mobile stations. ETSI 3GPP 04.18 v 9.0 discloses wherein a description of the second channel in the message System Information 13 is legible only to lu mobile stations (page 148, section 9.143a; page 244-245, section 10.5.2.26a). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify MILDH in view of the applicant's disclosure of the prior art to include the use of System Information 13, as taught by ETSI 3GPP 04.18 v9.0, since System Information 13 is a well known and conventional protocol used in GSM system to provide information related to GPRS within a cell (see page 148).

5. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over MILDH et al (US 2002/0193139 A1) in view of the applicant's disclosure of the prior art and ETSI 3GPP 04.18 v 9.0 as applied to claim 3 above, and further in view of RAITH (US 5,930,706).

Regarding claim 24, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. MILDH further discloses said lu to transfer the second message (paragraph 6, 11, 15-18). However, MILDH in view of the applicant's disclosure of the prior art and ETSI 3GPP 04.18 v 9.0 does not expressly disclose an indicator field indicating whether normal BCCH or extended BCCH is used to transfer a message. RAITH discloses an indicator field indicating whether normal BCCH or extended BCCH is used to transfer a message (paragraph 21, line 22-57). Therefore it

would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of MILDH n view of the applicant's disclosure of the prior art and ETSI 3GPP 04.18 v 9.0 to include an indicator field indicating whether normal BCCH or extended BCCH is used to transfer a message as taught by RAITH, since RAITH teaches that such a modification would allow a system to transmit information at various rates depending on importance.

Allowable Subject Matter

6. Claim 14 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
7. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record does not disclose wherein the single spare bit represents the only previously undedicated bit in the SI3 message.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

DALSGAARD (WO 00/16581) – Improved method for changing cells

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ARIEL BALAOING whose telephone number is (571)272-7317. The examiner can normally be reached on Monday-Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, V. Paul Harper can be reached on (571) 272-7605. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/VINCENT P. HARPER/
Supervisory Patent Examiner, Art Unit 2617

/Ariel Balaoing/
Examiner, Art Unit 2617

/A. B./
Examiner, Art Unit 2617